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26272 7590 09/16/2009 COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS NEW YORK, NY 10036				
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDEO TAKIGUCHI and ATSUSHI KUMAGAI

Appeal 2009-003223
Application 09/400,154
Technology Center 2600

Decided: September 16, 2009

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO,
and ELENI MANTIS MERCADER, *Administrative Patent Judges*.

MANTIS MERCADER, Administrative Patent Judge.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's rejection of claims 67-72 and 75. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

INVENTION

Appellants' claimed invention is directed to an image input device having a plurality of operation modes and a computer having a plurality of software programs corresponding to the plurality of operation modes (Spec. 6:25-7:3). The software program corresponding to the operation mode of the image input device is automatically started when the input device is connected to the computer and is turned on or when the image input device is turned to another operation (Spec. 7:3-11).

Claim 67, reproduced below, is representative of the subject matter on appeal:

67. An image input system, which includes an image input device having a plurality of operation modes and a computer having a plurality software programs each corresponding to each of the plurality of operation modes of the image input device, comprising:

- a transmitting unit adapted to transmit information indicating an operation mode set in said image input device to said computer when said image input device and said computer are connected with each other and a communication between said image input device and said computer is established;

- a receiving unit arranged in said computer and adapted to receive the information indicating the operation mode set in said image input device; and

- a control unit adapted to select a software program, which corresponds to the operation mode set in said image input device, from the plurality of software programs and make start the selected software program wherein when said image input device and said computer are disconnected in a state that said image input device and said computer are connected with each other and the software program corresponding to the operation mode of said image input device is operating, it is set in every software whether the software is kept in an operating state or an operation of the software is terminated.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Norris	US 5,864,411	Jan. 26, 1999
Camara	US 6,373,507 B1	Apr. 16, 2002 (filed Sep. 14, 1998)
Driscoll, Jr.	US 6,542,184 B1	Apr. 1, 2003 (filed Jun. 24, 1996)
Fukasaka	EP 0 860 978 A2	Aug. 26, 1998

The following rejections are before us for review:

1. The Examiner rejected claims 67, 68, 70, and 75 under 35 U.S.C. § 103(a) as being unpatentable over Fukasaka in view of Camara.
2. The Examiner rejected claims 69 and 72 under 35 U.S.C. § 103(a) as being unpatentable over Fukasaka in view of Camara and Norris.
3. The Examiner rejected claim 71 under 35 U.S.C. § 103(a) as being unpatentable over Fukasaka in view of Camara and Driscoll.

OBVIOUSNESS

ISSUE

Appellants contend inter alia that the Examiner is unclear and incomplete with respect to the limitation of “it is set in every software whether the software is kept in an operating state or an operation of the software is terminated” (App. Br. 12). Camara does not disclose, teach, or suggest how operation of the software corresponding to that imaging device would be handled when the imaging device

is disconnected from the computer (App. Br. 16-17). In other words, Camara does not teach or suggest whether the “My Camera” icon (160) and any software, which corresponds to that icon and/or the imaging device “My Camera,” could be activated or kept in an operating state when the icon is indicated as not available in the “Imaging Devices” window (110) in Figure 4 (Reply Br. 4). Camara describes, for example, that, “[i]n Fig. 4, the second scanner identified as ‘Jake’s Scanner’ is not available and hence the icon 118 is dimmed” (Reply Br. 5). However, Camara does not teach or suggest whether any software, which corresponds to an operation mode of “Jake’s Scanner,” can be kept in an operating state or an operation of that software is terminated when “Jake’s Scanner” is indicated as not available (Reply Br. 5).

The Examiner finds that Camara teaches that “The ‘Imaging Devices’ window 110 distinguishes between devices that are currently available and those that are not available (e.g., offline, physically removed, etc.)” (col. 4, ll. 58-62) (Ans. 13). In other words, the software program distinguishes between situations when the imaging device is physically attached or physically removed from the computer (Ans. 13). “Since, the software distinguishes in the ‘Imaging Devices’ window /GUI (110), the software must continue to operate even though the imaging device is physically removed from the computer” (Ans. 13). The Examiner notes that there is nothing in the claim language that prevents the “image acquisition system” of Camara to be the software corresponding to that imaging device (Ans. 13).

The issue before us, then, is as follows:

Have Appellants shown that the Examiner erred by finding that Camara teaches the limitation of “*a software program, which corresponds to the operation*

mode set in said image input device . . . it is set in every software whether the software is kept in an operating state or an operation of the software is terminated” as recited in claims 67 and 75?

FINDINGS OF FACT

The relevant findings of fact (FF) include the following:

1. Camara teaches that “The ‘Imaging Devices’ window 110 distinguishes between devices that are currently available and those that are not available (e.g., offline, physically removed, etc.)” (col. 4, ll. 58-62) (Ans. 13).
2. Camara teaches that the imaging devices window allows installing devices of interest (i.e., “My Camera” icon 116 or “Jake’s scanner” icon 118 in Fig. 4) and when the devices are unavailable their respective icons are dimmed (col. 4, ll. 46-64).

PRINCIPLES OF LAW

“The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art.” *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994).

ANALYSIS

Camara teaches that “The ‘Imaging Devices’ window 110 distinguishes between devices that are currently available and those that are not available (e.g., offline, physically removed, etc.)” (col. 4, ll. 58-62) (FF 1). We agree with the Examiner (Ans. 13) that the software program distinguishes between situations when the imaging device (i.e., “My Camera” icon 116 in Fig. 4) is physically

attached or physically removed from the computer (i.e., dimmed icon) (FF 2). We also agree with the Examiner (Ans. 13) that the software in the “Imaging Devices” must continue to operate even though the imaging device is physically removed from the computer. However, Camara teaches that the devices that are not available are dimmed allowing the user the option to uninstall them (col. 4, ll. 58-64). Thus, Camara’s software simply distinguishes whether the imaging device is not available (i.e., offline or physically removed). However the claim language as recited in claims 67 and 75 is not computer software that continues to operate when the camera is detected as unavailable.

Claims 67 and 75 don’t simply recite a computer software program but rather “*a software program, which corresponds to the operation mode set in said image input device.*” Thus, we agree with Appellants (Reply Br. 5) that Camara does not teach or suggest whether any software, which corresponds to an operation mode of “Jake’s Scanner” (i.e., imaging device), can be kept in an operating state or an operation of that software is terminated when “Jake’s Scanner” is indicated as not available.

Accordingly, we disagree with the Examiner’s assertion (Ans. 13) that nothing in the claim language prevents the “image acquisition system” of Camara to be the software corresponding to that imaging device, because that statement completely ignores the limitation that the “*software program . . . corresponds to the operation mode set in said image input device*” (emphasis added). As stated *supra*, the Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *Lowry*, 32 F.3d at 1582.

Further, we find that Norris and Driscoll fail to cure the shortcomings of the Fukasaka and Camara combination.

For the above reasons, Appellants have shown error in the Examiner's rejection of claims 67 and 75 under 35 U.S.C. § 103(a). For similar reasons, we are likewise persuaded of error in the Examiner's rejection of dependent claims 68-72.

CONCLUSION

Under 35 U.S.C. § 103, Appellants have shown that the Examiner erred by finding that Camara teaches the limitation of "a software program, which corresponds to the operation mode set in said image input device . . . it is set in every software whether the software is kept in an operating state or an operation of the software is terminated."

ORDER

The decision of the Examiner to reject claims 67-72 and 75 under 35 U.S.C. § 103(a) is reversed.

REVERSED

gvw

COWAN LIEBOWITZ & LATMAN P.C.
JOHN J TORRENTE
1133 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

